

Remarks

Reconsideration of the application is requested. Claims 1, 4-10, 13, 15, 19, 30-33, 35-39, and 41 are now in the application. Claims 4, 30, and 35 have been amended. Claim 41 has been added. Claim 33 was withdrawn. Claims 21-22, 25-29, 34, and 40 have been canceled.

In the second paragraph on page 2 of the Office action, the Examiner withdrew claim 33 as being drawn to a non-elected species. Claim 33 describes, “The implantable device according to claim 30, further comprising a means for changing from the wide position to the narrow position.” The election made on April 13, 2005, was for the embodiment shown in Fig. 9, which *inter alia* is a wedge shape that is pushed between two bones of a joint. A means for changing from the wide position to the narrow position is a device for pushing the wedge into the joint. Such a means is a subcombination of the elected invention and should not have been withdrawn. Accordingly, Applicant requests rejoinder of claim 33.

In the fourth paragraph on page 2 of the Office action, the Examiner rejected claims 1, 4-10, 13, 15, 19, 21-22, and 30-40 under 35 USC § 101 as being drawn to non-statutory subject matter. First, these claims are directed to machines (i.e. devices) which are one of the statutory classes specified in 35 USC § 101. More relevantly, the bones described in the claims are never positively claimed. Rather, the bones are the work piece with which the positively claimed device interacts. *See* MPEP § 2115. For example claim 30 merely positively claims: “30. An implantable device ..., comprising a first surface ...; a second surface ...; and a body.” The positively-announced parts all belong to the implantable device. The bones are only inferentially introduced and not positively claimed. Accordingly, the claims do not positively claim natural subject matter.

If these remarks are not persuasive, Applicant requests that the Examiner discuss the rejection with her supervisor and then call the undersigned attorney to discuss the rejection.

The features of claim 40 and its intervening base dependent claim (i.e. claim 34) have been integrated into claim 34. This amendment should be entered, even after final, because the combination was previously searched as prior claim 40; therefore, no additional search is necessary. The other independent claim (i.e. claim 25) and its related dependent claims have been canceled.

For the reasons discussed below, if the combination in amended claim 30 is patentable, the other claims depending on claim 30 should also be allowable. Accordingly, the amendment to claim 30 should be entered even though the case is “After Final” because the amendment does not necessitate a further search and it places the case in condition for allowance or at least better condition for appeal.

Amended claim 30, which now includes the features of claims 34 and 40 is patentable because the rejection in the second full paragraph on page 4 of the Office action based on Stone ‘433 in view of Michelson ‘635 under 35 USC § 103(a) failed to make *prima facie* case of obviousness as is required under 35 USC § 103(a). In the final paragraph on page 4 of the Office action, the Examiner further explains the rejection stating, “Stone discloses the claim [sic] invention except for the device being coated with a bone growth promoting material...” However, this is not the case.

Stone ‘433 in view of Michelson ‘635 would not suggest to one with ordinary skill in the art a device that is implanted between a joint formed by two bones, wherein, “The implant is connected to only one of the bones.”

Stone ‘433 teaches an osteotomy device. Osteotomy devices are wedged into one bone. The wedge is then fastened with screws with flanges on the posterior side and the anterior side of the wedge; *see* Fig. 2B. As discussed by the Examiner, Michelson ‘635 involves other features. Accordingly, one with ordinary skill in the art reading Stone ‘433 would at best be taught a wedge that is inserted into a joint and that attaches to both bones forming the joint. Stone ‘433 would not suggest to one with ordinary skill in the art to connect the device to only one of the bones in the joint.

Furthermore, as discussed in the specification and in the previous Declaration under Rule 1.132 such a device has the added utility of moving bones relative to each other but still allowing movement of the joint.

The other rejections are now moot in light of the amendment to claim 30 and the cancellation of claim 25.

More specifically, in the second full paragraph on page 3, the Examiner rejected claims 1, 8-9, 13, 19, 30-32, and 39 as being fully anticipated by Stone '433 under 35 U.S.C. § 102(e). The rejection is now moot in light of the amendment to claim 30.

In the third full paragraph on page 5 of the Office action, the Examiner rejected claims 4-7 as being unpatentable over Stone '433 in view of Michelin '635 and Jefferies '370 under 35 USC § 103(a). These rejections are moot in light of the amendment to claim 30.

In the final paragraph on page 5 of the Office action, the Examiner rejected claims 15, 36-38, and 21-22 under Stone in view of Henderson '175 under 35 USC § 103(a). These rejections are moot in light of the amendment to claim 30. Applicant further notes that Henderson '175 teaches to attach both bones forming a joint to the device.

In the fourth paragraph on page 6 of the Office action, the Examiner rejected claim 10 as being unpatentable over Stone in view of Zdeblick et al. '909. This rejection is moot in light of the amendment to the base claim, claim 30.

In the first paragraph on page 7 of the Office action, the Examiner rejection claims 25-27 as being unpatentable over Stone '433 in view of Michelson '635 and Henderson et al. '175. This rejection is moot because the claims have been canceled.

In the fourth paragraph on page 8 of the Office action, the Examiner rejected claim 28 as being unpatentable over Stone '433 in view of Michelson '635 and Henderson et al. '175 in view of Zdeblick et al. '909 under 35 USC § 103(a). The rejection is moot because claim 28 has been canceled.

Claim 41 has been added. Claim 41 is similar to amended claim 30 but does not include the features of claim 34. While the exact combination of features admittedly has not been searched before, Applicant still believes that the new claim should be entered because it contains the relevant, patentable features that are necessary to distinguish the device from the prior art. If the addition of this claim would prevent the allowance of the application, the Examiner is asked to telephone the undersigned attorney so it could be discussed.

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Application No.: 10/775,996
Examiner: Hoffman, Mary C.

In view of the foregoing, reconsideration and allowance of claims 1, 4-10, 13, 15, 19, 30-33, 35-39, and 41 are solicited. In the event the Examiner should still find any of the claims to be unpatentable, please telephone counsel so that patentable language can be substituted. In the alternative, the entry of the amendment is requested as it is believed to place the application in better condition for appeal, without requiring extension of the field of search.

If an extension of time for this paper is required, petition for extension is herewith made.

No fee is believed due. However, please charge any required fee (or credit any overpayments of fees) to the Deposit Account of the undersigned, Account No. 500601 (Docket No. 780-A03-021-5).

Respectfully submitted,

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